

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Craig R. White	Examiner:	Hatem M. Ali
Serial No.:	09/977,687	Art Unit:	3692
Filed:	October 16, 2001	Docket No.:	10011785-1
Title:	CENTRALIZED BILLING CREDIT SYSTEM UTILIZING A PREDETERMINED UNIT OF USAGE		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief – Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Appeal Brief is submitted in support of the Notice of Appeal filed December 3, 2009, appealing the rejection of claims 1-2, 5-8, 21, and 23-26 of the above-identified application as set forth in the Final Office Action mailed September 3, 2009.

The U.S. Patent and Trademark Office is hereby authorized to charge **Deposit Account No. 08-2025** in the amount of **\$540.00** for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. § 41.20(b)(2). At any time during the pendency of this application, please charge any required fees or credit any overpayment to Deposit Account No. 08-2025.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1, 2, 5-8, 21, and 23-26.

**Appeal Brief to the Board of Patent Appeals and Interferences
of the United States Patent and Trademark Office**

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REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP having a principal place of business at 11445 Compaq Center Drive West, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

Appellant submits that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, 5-8, 21, and 23-26 are pending in the application (see Claims Appendix), and are the subject of the present Appeal. Claims 3-4, 9-20, and 22 were previously cancelled without prejudice.

Claims 1-2, 5-8, 21, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi, U.S. Patent No. 6,385,675 in view of Okuda et al., U.S. Patent No. 7,034,952 and Aikens, U.S. Patent No. 6,216,113.

STATUS OF AMENDMENTS

No amendments have been entered subsequent to the Final Office Action mailed September 3, 2009.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number (or paragraph number) and to the drawings by reference characters, as required by 37 CFR 41.37(c)(1)(v). Note that the reference to passages in the specification and reference characters in the drawings for each element of the claims does not imply that limitations from the specification and drawings should be read into the corresponding claim element or that

these references are the sole sources in the specification and the drawings supporting the claim features.

Independent claim 1 provides an electronic transaction recording system for accumulating data from a printer device. The system includes a billing policies database (e.g., billing policies database 6) which includes billing policies for a printer device (e.g., printer device(s) 12) having an owner and a user; a billing manager (e.g., billing manager (4)) which is implemented by a processor, coupled to the billing policies database and the printer device, and uses at least one of the billing policies to determine a cost of each operation performed on the printer device (as described, e.g., at page 5, line 19 - page 6, line 3); a billing system (e.g., billing system 8) which accumulates information on usage of the printer device by the user, generates an accounting of usage based on the information, and associates the accounting of usage with a predetermined unit of usage (as described, e.g., at page 6, lines 4-17); and an account records database (e.g., account records database 10) which stores account information of the user of the printer device in terms of the predetermined unit of usage (as described, e.g., at page 8, lines 12-27); wherein the billing system periodically updates the account information of the user of the printer device and issues an accounting of costs to the user of the printer device (as described, e.g., at page 8, line 28 - page 9, line 12), wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user (as described, e.g., at page 9, lines 13-18), and wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device (as described, e.g., at page 4, lines 1-4; page 5, line 19 - page 6, line 3) (see also Figs. 1 and 2; page 6, line 18 - page 8, line 27; Figs. 3 and 4; page 8, line 28 - page 10, line 8).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant seeks review of the rejection of claims 1-2, 5-8, 21, and 23-26 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi, U.S. Patent No. 6,385,675 in view of Okuda et al., U.S. Patent No. 7,034,952 and Aikens, U.S. Patent No. 6,216,113.

ARGUMENT

I. Rejections Under 35 U.S.C. §103

A. Applicable Law

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In identifying a reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art teachings, the Examiner must show some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)).

Further, a rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). *See also In re Kahn*, 441 F.3d at 988 (Fed. Cir. 2006).

B. Rejection of claims 1-2, 5-8, 21, and 23-26 under 35 U.S.C. 103(a)

Because the rejection of claims 1-2, 5-8, 21, and 23-26 under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi, U.S. Patent No. 6,385,675 in view of Okuda et al., U.S. Patent No. 7,034,952 and Aikens, U.S. Patent No. 6,216,113 fails to establish a *prima facie* case of obviousness, the rejection of claims 1-2, 5-8, 21, and 23-26 is not correct and should be withdrawn.

Independent claim 1 includes, amongst other, **"a billing policies database which includes billing policies for a printer device having an owner and a user," "a billing system which accumulates information on usage of the printer device by the user, generates an accounting of usage based on the information, and associates the**

accounting of usage with a predetermined unit of usage," and "a billing manager which is implemented by a processor, coupled to the billing policies database and the printer device, and uses at least one of the billing policies to determine a cost of each operation performed on the printer device," wherein "the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user," and wherein "the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device."

Thus, independent claim 1 includes billing policies for a printer device having an owner and a user, wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user, and wherein the billing system accumulates information on usage of the printer device by the user, accumulates information on usage of the printer device by the owner, and only bills the owner of the printer device for net usage of the printer device.

The Examiner recognizes that the Yamaguchi reference does not disclose an account records database which stores account information of the user of the printer device in terms of the predetermined unit of usage and wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device (Final Office Action 09/03/2009, page 4), and recognizes that the Yamaguchi reference does not disclose wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user (Final Office Action 09/03/2009, page 5).

As such, the Examiner contends that the Aikens reference discloses an account records database which stores account information of the user of the printer device in terms of the predetermined unit of usage and wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device, and suggests that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yamaguchi to include the disclosures as taught by Aikens (Final Office Action 09/03/2009, page 4). In addition, the Examiner contends that the Okuda reference discloses that the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of

usage of the printer device by the user, and suggests that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yamaguchi to include the disclosures as taught by Okuda (Final Office Action 09/03/2009, page 5).

Regarding the Yamaguchi reference, the Yamaguchi reference discloses a printer or copying machine which operates according to several different functional and operational modes, a host computer which sends a print or copy order to the printer or copying machine, and an accounting means which calculates charges based on the order before it is carried out by the printer or copying machine and which transmits those charge to the host computer (see Abstract). More specifically, the Yamaguchi reference discloses an image processor 10I which includes an account processor 10IH for processing the cost of the job based on an accounting program, and a controller 10II for controlling the accounting operations, the image processing operations, the communications, and the changing of the accounting programs (see Yamaguchi, Fig. 2; col. 2, lines 54-65).

As such, the Yamaguchi reference provides that the controller 10II controls the digital copying machine 100 so that it carries out a function specified by one of the host computers 102 such that the controller then logs the job and prepares an account based on the log, and gives an account notice to each host computer according to a predetermined timing, wherein the account notice may be sent to the appropriate host computer 102 along with each copying job, or periodically, such as monthly, or when the total charge exceeds a predetermined amount, or as requested by the user (Yamaguchi, col. 2, line 65 - col. 3, line 8).

In this regard, the Yamaguchi reference provides that:

The accounting operation is carried out based on the following parameters: an acceptance time (this may be, for example, a week, a day or a holiday, daytime or nighttime, etc.), the number of pages to be copied, the kind of paper to be used in the copying operation, such as ordinary paper or OHP (Overhead Transparency Paper), etc., paper size, size of the file, name of the user (discountable or not), copy mode (full-color copy or mono-color copy, etc. in a case where the copying machine 100 is a color copying machine), necessity for logging after copying, user functions (these may be expansion functions or ordinary functions) and time (emphasis added) (Yamaguchi, col. 3, lines 9-21).

In the accounting operation, however, the Yamaguchi reference does not disclose crediting the owner of the printer or copying machine an amount corresponding to a

predetermined unit of usage of the printer or copying machine by the user, and does not disclose only billing the owner of the printer or copying machine for net usage of the printer or copying machine. More importantly, the Yamaguchi reference does not even mention the owner of the printer or copying machine. The Yamaguchi reference, therefore, does not disclose a billing system which accumulates information on usage of a printer device by a user, generates an accounting of usage based on the information, and associates the accounting of usage with a predetermined unit of usage, wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user, and wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device, as claimed in independent claim 1.

Regarding the Okuda reference, the Okuda reference relates to a print service system capable of improving user settlement convenience by setting a charging system depending upon each service type and dynamically determining a fee depending upon the past use records of a user to provide services specific to each user (see Okuda, Abstract). The print service system of the Okuda reference includes a settlement maker 409 which performs a settlement process for a charge depending upon user use records, a pay settlement process and royalty settlement process for each print service shop, and includes a fee system unit 453 which manages a standard fee table for each service, a user charge management attribute reference table which is used as a calculation reference to various charge process services depending upon use records, a contracted shop royalty reference table which is used as a reference to royalty calculation of each contracted shop depending upon service records, and other tables (Okuda, col. 4, lines 39-42 and 61-67). Neither the settlement maker of the Okuda reference nor the fee system unit of the Okuda reference, however, accumulates information on usage of a printer device by an owner of the printer device and only bills the owner of the printer device for net usage of the printer device, as claimed in independent claim 1.

Regarding the Aikens reference, the Aikens reference relates to an electronic network transaction recording system for accumulating billing data for printing machines interconnected to multiple work stations on the network, wherein requests for print jobs are verified and billed to an individual or group billing account number (see Aikens, Abstract).

In this regard, the Aikens reference provides that:

The billing data can be charged to individual accounts, to group accounts, or to predetermined stations. Also, credit systems can be provided. That is, the account system can be set up to allow for predetermined usage per individual account or group account. Upon exceeding the allowed credit, access to a given printer would be excluded (emphasis added) (Aikens, col. 4, lines 37-42).

Regarding "credit," the Aikens reference provides that:

Assuming that there is sufficient credit to perform the requested job, then access is allowed and the billing counters are appropriately set... (emphasis added) (Aikens, col. 5, lines 41-43).

And, provides that:

...if there is a usage limit for the particular account, there would be a recalculation of the remaining credit for that particular account to determine the available capacity or a usage available for the next requested job from the account (emphasis added) (Aikens, col. 5, line 64 - col. 6, line 4).

Thus, the disclosed "credit" of the Aikens reference is with regard to "predetermined usage" per individual account or group account. The "credit" of the Aikens reference, however, is not with regard to crediting an owner of a printer device an amount corresponding to a predetermined unit of usage of the printer device by a user.

Accordingly, Appellant submits that modifying the Yamaguchi reference in view of the Okuda and Aikens references does not overcome the shortcomings of the Yamaguchi reference. More specifically, Appellant submits that the combination of the Yamaguchi, Okuda, and Aikens references does not disclose a billing system which accumulates information on usage of a printer device by a user, generates an accounting of usage based on the information, and associates the accounting of usage with a predetermined unit of usage, wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user, and wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device, as claimed in independent claim 1. Appellant notes that to establish *prima facie* obviousness of

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a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 1, and submits that independent claim 1 is patentably distinct from the Yamaguchi, Okuda, and Aikens references. Furthermore, as dependent claims 2, 5-8, 21, and 23-26 further define patentably distinct claim 1, Appellant submits that these dependent claims are also patentably distinct from the Yamaguchi, Okuda, and Aikens references. Appellant, therefore, respectfully submits that the rejection of claims 1-2, 5-8, 21, and 23-26 under 35 U.S.C. 103(a) is not correct and should be withdrawn, and submits that claims 1-2, 5-8, 21, and 23-26 should be allowed.

For at least the reasons set forth above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of claims 1-2, 5-8, 21, and 23-26. Appellant, therefore, respectfully submits that the rejection of claims 1-2, 5-8, 21, and 23-26 under 35 U.S.C. 103(a) is not correct and should be withdrawn, and submits that claims 1-2, 5-8, 21, and 23-26 should be allowed.

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CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Appeal Brief should be directed to either Jack H. McKinney at Telephone No. (208) 396-4140 or Scott A. Lund at Telephone No. (612) 573-2006.

Respectfully submitted,

Craig R. White,

By,

DICKE, BILLIG & CZAJA, PLLC

Fifth Street Towers, Suite 2250

100 South Fifth Street

Minneapolis, MN 55402

Telephone: (612) 573-2006

Facsimile: (612) 573-2005

Date: FEB. 3, 2010

SAL:skh

/SCOTT LUND/

Scott A. Lund

Reg. No. 41,166

CLAIMS APPENDIX

1. (Previously Presented) An electronic transaction recording system for accumulating data from a printer device, the system comprising:

a billing policies database which includes billing policies for a printer device having an owner and a user;

a billing manager which is implemented by a processor, coupled to the billing policies database and the printer device, and uses at least one of the billing policies to determine a cost of each operation performed on the printer device;

a billing system which accumulates information on usage of the printer device by the user, generates an accounting of usage based on the information, and associates the accounting of usage with a predetermined unit of usage; and

an account records database which stores account information of the user of the printer device in terms of the predetermined unit of usage;

wherein the billing system periodically updates the account information of the user of the printer device and issues an accounting of costs to the user of the printer device,

wherein the billing system credits the owner of the printer device an amount corresponding to the predetermined unit of usage of the printer device by the user, and

wherein the billing system accumulates information on usage of the printer device by the owner of the printer device, and only bills the owner of the printer device for net usage of the printer device.

2. (Original) The system of claim 1, wherein the predetermined unit of usage is a token.

3-4. (Cancelled)

5. (Previously Presented) The system of claim 1, further comprising a mobile access unit coupled to the billing manager, wherein the mobile access unit indicates content to be printed at the printer device.

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6. (Original) The system of claim 5, wherein the mobile access unit is selected from the group consisting of a personal digital assistant, a wireless telephone and a mobile computer.
7. (Previously Presented) The system of claim 1, further comprising a user configuration unit coupled to the billing polices database for updating and configuring billing polices for new users of the printer device.
8. (Original) The system of claim 1, wherein the billing system is selected from a back office billing system and an Internet Settlement Model.
- 9-20. (Cancelled)
21. (Previously Presented) The system of claim 1, further comprising:
a mobile access unit containing content which is to be printed;
wherein the system further comprises a plurality of printer devices connected over a network, wherein each printer device can receive the content from the mobile access unit and print the content in response to an authorization process; and
wherein the billing manager is coupled to each printer device and the mobile access unit for determining an amount of printer usage and associating a predetermined amount of token values with the amount of printer usage.
22. (Cancelled)
23. (Previously Presented) The system of claim 21, wherein the mobile access unit is selected from a personal digital assistant, a wireless telephone, and a mobile computer.
24. (Previously Presented) The system of claim 21, wherein the mobile access unit transmits using a wireless link.

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25. (Previously Presented) The system of claim 21, further comprising a user configuration unit coupled to the billing polices database for updating and configuring billing polices for new users of the printer devices.

26. (Previously Presented) The system of claim 21, wherein the billing system is selected from a back office billing system and an Internet Settlement Model.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.